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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,883	02/07/2005	Erwin Junker	F-8540	4397

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EXAMINER

MORGAN, EILEEN P

ART UNIT PAPER NUMBER

3723

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/523,883	JUNKER, ERWIN	
	Examiner	Art Unit	
	Eileen P. Morgan	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-7-05 & 3-14-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Cl. 1, line 7, 'held on one side' is unclear. Side of what? 'its exterior circumference' lacks antecedent basis. Line 8, 'the rotating circ', 'the first cyl. Grinding wh.' Lack antecedence. Is the machine part held by the grinding wheel? Line 9, 'perpendicularly' refers to what? Line 10, the phrase 'in the direction of its rotational axis' is used several times throughout the claims. This direction is unclear and this axis lacks antecedence. What constitutes the 'axial extension'? This lacks antecedence. How does it 'cover'? 'the radial angled' lacks antecedence as well. Line 14, what does 'in the same clamping' mean? Line 15, 'of smaller diameter' than what? Last line 'and placed....' is unclear. Cl. 3, what does 'peel' grinding' mean? Cl. 6, 'their working positions' lack antecedence. Cl. 7 has similar problems as claim 1, including many antecedent basis problems. Careful review for clarity is necessary. The last paragraph of cl. 7 does not make sense. There is no mention of the second wheel grinding the workpiece. Cl. 8, 'their axes' lack antecedence, as well as, 'the same side'. Cl. 11 is unclear and seems redundant to cl. 7, paragraph 4.

Claim Rejections - 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-8, 10,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP-361446 in view of Gruber -4,051,830.

EP-446 discloses an apparatus and method for grinding a cylindrical workpiece externally and internally via grinding wheels Gc and Gb, respectively, wherein the workpiece is held on one end via clamping means (20) , said workpiece being displaced in the direction of the rotational and longitudinal axes, wherein the grinding wheels are mounted on the same side of a headstock that pivots the grinders into

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working position. EP' 446 does not disclose the workpiece having a frusto-conical form. However, Gruber teaches grinding a cylindrical workpiece having a frusto-conical form (13) by a grinding wheel that has a peripheral grinding surface extending to cover the radial angled extension as it grinds. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to use the apparatus and method disclosed by EP 446 on a workpiece having a frusto-conical shape, as taught by Gruber, in order to machine a variety of parts having various end shapes. The axial extent of the grinding surface relative to the radial extent of the workpiece would be dependent on size of workpiece and the choice of these sizes would be within the level of ordinary skill. In regards to cl. 3, the type of grinding by the internal grinder would have a matter of obvious design choice, dependent on finish desired.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB-22457 in view of Gruber-4,051,830 .

GB-457 discloses an apparatus and method for grinding a cylindrical workpiece externally and internally via grinding wheels (19-24), wherein the workpiece is held on one end via clamping means (14) , said workpiece being displaced in the direction of the rotational and longitudinal axes, wherein two of the grinding wheels are mounted on the 'same' side of a headstock (considering the headstock has three sides with 2 grinders on each side. Three of the grinding wheels are spaced 120° apart (19, 21, 23)) that pivots the grinders into working position. GB-457 does not disclose the workpiece having a frusto-conical form. However, Gruber teaches grinding a cylindrical workpiece having a frusto-conical form (13) by a grinding wheel that has a peripheral grinding surface extending to cover the radial angled extension as it grinds. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to use the apparatus and method disclosed by GB-457 on a workpiece having a frusto-conical shape, as taught by Gruber, in order to machine a variety of parts having various end shapes. The axial extent of the grinding surface relative to the radial extent of the workpiece would be dependent on size of workpiece and the choice of these sizes would be within the level of ordinary skill. In regards to cl. 3, the type of grinding by the internal grinder would have a matter of obvious design choice, dependent on finish desired.

6. Claims 6,9 rejected under 35 U.S.C. 103(a) as being unpatentable over EP-446 in view of Gruber '830, as applied to claims above, and further in view of GB-'457.

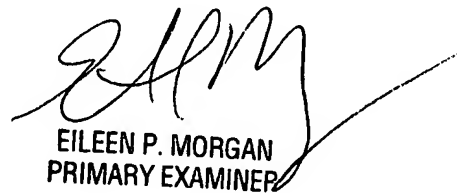
EP-446 discloses an apparatus and method for grinding a cylindrical workpiece as discussed above. EP-446 does not disclose the headstock having 3 grinding wheels spaced apart by 120°. However, GB-457 teaches grinding a workpiece externally and internally via grinding wheels mounted on a pivoting headstock. GB-457 shows 6 grinding wheels (19-24) wherein 3 of them (19, 21, 23) or (20, 22, 24) are spaced 120° apart. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to provide EP-446 with a third grinding wheel, as taught by GB-457, in order to perform multiple grinding tasks on a workpiece in one clamping session, such as rough grinding and finish grinding, internally or externally.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Monday-Thursday (Office), Friday (Work at home).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM
September 16, 2005


EILEEN P. MORGAN
PRIMARY EXAMINER